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Docket No. 4439-4023



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Tetsuro Kokubo et al

Group Art Unit: tba

Serial No.: 10/501,039

Examiner: tba

Filed: July 8, 2004

For: METHOD OF MONITORING GENE EXPRESSION

INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

**RECEIVED
 OIPE/AP
 AUG 26 2005**

Sir:

This Information Disclosure Statement is filed in accordance with 37 C.F.R. §§1.56, 1.97 and 1.98. The items listed on Form PTO-1449, a copy of which is enclosed, are made of record to assist the Patent and Trademark Office in its examination of this application. The Examiner is respectfully requested to fully consider the items and to independently ascertain their teaching.

1. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, an English language translation of that item or a portion thereof or a concise explanation of the relevance of that item is enclosed:

2. ☐ For each of the following items listed on the enclosed copy of Form PTO-1449 that is not in the English language, a concise explanation of the relevance of that item is incorporated in the specification of the above-identified application.

3. ☐ Any copy of the items listed on the enclosed copy of Form PTO-1449 that is not enclosed with this Information Disclosure Statement was previously cited by or submitted to the Patent and Trademark Office in application Serial No. _____, filed _____.

4. ☒ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with:

☐ 37 C.F.R. §1.97(b)(1), within three months of the filing date of a national application other than a CPA; or


- ☐ 37 C.F.R. §1.97(b)(2), within three months of the date of entry into the national stage as set forth in §1.491 in an international application; or
- ☒ 37 C.F.R. §1.97(b)(3), before the mailing date of a first Office action on the merits; or
- ☐ 37 C.F.R. §1.97(b)(4) before the mailing date of a first office action after the filing of an RCE under §1.114.
5. ☐ No fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a Notice of Allowance (where there has been no prior final action), and is accompanied by one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below.
6. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(c), after the period specified in paragraph 4 above but before the mailing date of a final action or a notice of allowance (where there has been no prior final action):
- ☐ A check in the amount of \$180.00 is enclosed in payment of the fee.
- ☐ Charge the fee to Deposit Account No. 13-4500, Order No. _____. A
DUPLICATE COPY OF THIS SHEET IS ATTACHED.
7. ☐ A fee is due under 37 C.F.R. §1.17(p) for this Information Disclosure Statement since it is being filed in compliance with 37 C.F.R. §1.97(d), after the mailing date of a final action or a notice of allowance, whichever comes first, but before payment of the issue fee, and is accompanied by:
- a. one of the certifications pursuant to 37 C.F.R. §1.97(e) set forth in paragraph 9 below; and
- b. the fee due under 37 C.F.R. §1.17(p) which is paid as set forth in paragraph 11 below.
8. ☐ This Information Disclosure Statement is being filed in compliance with:
- a. ☐ 37 C.F.R. §1.313(b)(3) or §1.313(c)(1), after the issue fee has been paid and information cited in this Information Disclosure Statement may render at least one claim unpatentable and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h);
- b. ☐ 37 C.F.R. §1.313(c)(2) or §1.313(c)(3), after the issue fee has been paid and information cited in this Information Disclosure Statement is to be considered in a Request for Continued Examination (RCE) or a Continuation application upon abandonment of the instant application and is accompanied by the attached Petition To Withdraw Application From Issue and fee pursuant to 37 C.F.R. §1.17(h).

- c. ☐ The fee due under 37 C.F.R. §§1.17(h) is paid as set forth in paragraph 11 below.
9. ☐ I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- ☐ I hereby certify that no item of information in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application or, to my knowledge after making reasonable inquiry, was known to any individual designated in §1.56(c) more than three months prior to the filing of this Information Disclosure Statement.
10. ☐ This document is accompanied by ☐ a Search Report ☐ Communication which was cited in a corresponding ☐ PCT or ☐ Foreign counterpart application
11. ☐ A check in the amount of \$ _____ is enclosed in payment of the fees due under 37 C.F.R. §§1.17(h) and 1.17(p).
- ☐ Charge the fees due under 37 C.F.R. §§1.17(h) and 1.17(p) to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4439-4023. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

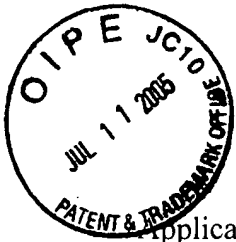
Dated: July 11, 2005

By: _____


Kenneth H. Sonnenfeld / Michael A. Willis
Reg. No. 33, 285 / Reg. No. 53, 913

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EXPRESS MAIL CERTIFICATE

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Commissioner for Patents
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Express Mail Label No.: EV 622 503 978 US

Date of Deposit: July 11, 2005

I hereby certify that the following attached paper(s) and/or fee

1. Information Disclosure Statement (3 pages + duplicate page)
2. Form PTO 1449A (1 page)
3. Form PTO 1449B (1 page)
4. copies of 7 cited references
5. return postcard

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Michael A. Willis

(Typed or printed name of person mailing papers(s) and/or fee)

(Signature of person mailing paper(s) and/or fee)

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INFORMATION DISCLOSURE CITATION

 Attorney Docket:
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 Serial No.:
10/501,039

 Applicant:
Tetsuro Kokubo et al

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 Group Art Unit:
tba

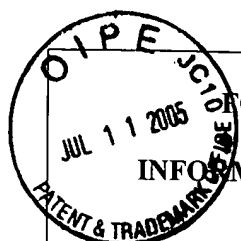
U.S. PATENT / PUBLICATION DOCUMENTS

Examiner Initial		Patent/Publication Number	Publication/Issue Date	Name	Filing Date
	1.				
	2.				
	3.				
	4.				
	5.				
	6.				
	7.				
	8.				
	9.				
	10.				
	11.				
	12.				
	13.				
	14.				

FOREIGN PATENT DOCUMENTS

Examiner Initial		Patent Number	Publication Date	Country	Copy Filed	Translation
	15.	WO 03/075747 A2	Sept. 18, 2003	WIPO	<input checked="" type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No
	16.				<input type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No
	17.				<input type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No
	18.				<input type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No
	19.				<input type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No
	20.				<input type="checkbox"/> Yes	<input type="checkbox"/> Yes <input type="checkbox"/> No

Examiner	Date Considered
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP §609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.	



FORM PTO-1449B

INFORMATION DISCLOSURE
CITATION

Attorney Docket:

4439-4023

Serial No.:

10/501,039

Applicant:

Tetsuro Kokubo et al.

Filing Date:

July 8, 2004

Group Art Unit:

tba

NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
	1.	G. Walter et al, "Noninvasive measurement of gene expression in skeletal muscle," Proc. Natl. Acad. Sci., vol. 97, no. 10, pages 5151-5155, May 9, 2000.
	2.	R. Weissleder et al, "MR Imaging and Scitigraphy of Gene Expression through Melanin Induction," Radiology, vol. 204, pages 425-429, 1997.
	3.	M. Rivera et al, "Gene Synthesis, Bacterial Expression, and 1H NMR Spectroscopic Studies of the Rat Outer Mitochondrial Membrane Cytochrome b5," Biochemistry, vol. 31, pages 12233-12240, 1992.
	4.	A. Koretsky et al, "NMR detection of creatine kinase expressed in liver of transgenic mice: Determination of free ADP levels," Proc. Natl. Acad. Sci., vol. 87, pages 3112-3116, April 1990.
	5.	T. van Voorthuysen et al, "Introduction of polyphosphate as a novel phosphate pool in the chloroplast of transgenic potato plants modifies carbohydrate partitioning," Journal of Biotechnology, vol. 77, pages 65-80, 2000.
	6.	R. Weissleder et al, "Molecular Imaging," Radiology, vol. 219, pages 316-333, 2001.
	7.	
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	12.	
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	14.	
	15.	

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.